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EXAMINER

GLESSNER, BRIAN E

ART UNIT PAPER NUMBER

3635

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/239,878

Applicant(s)

BOYER ET AL.

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,34,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,34,36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The following office action is in response to the amendment filed on November 22, 2004. Claims 33, 34, 36 and 37 are pending in the application. Claims 33, 34, 36 and 37 stand rejected as set forth below.

Claim Rejections - 35 USC § 103

Claims 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCaul, 111 et al. (3,762,115) in view of Hsu (5,210,985).

In regard to claims 33 and 36, McCaul discloses an apparatus comprising a seamless housing body (figures 10 and 11, column 3, lines 49-54) unitarily formed as a single piece, said seamless housing body having portions defining a front wall having a door opening there through (figure 10), a rear wall, two side walls, a roof and a floor (figure 11), a door frame positioned in the door opening, and a door mounted in the door frame, whereby said vault walls, roof, and floor are fireproof and burglary proof because they are made of concrete. McCaul does not specifically disclose that said door and is fire resistant and burglary proof. Hsu teaches that it is known to place a fire resistant/burglary proof door and frame on a bathroom module. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Hsu's teaching into McCaul's invention, because the door and frame taught by Hsu will make McCaul's module a safe place to hide from a fire or a burglar. The examiner would like to point out that McCaul and Hsu do not specifically disclose that their structures are vaults. However, since they disclose all of the claimed limitations, their structures could serve as vaults, i.e. anything desired could be locked inside them

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so that it would not be stolen. The term vault merely recites what the structure is to be used for and does not imply any specific structure.

Claims 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCaul, 111 et al. (3,762,115) in view of Hsu (5,210,985) and further in view of Wokas (3,162,863).

In regard to claims 34 and 37, McCaul in view of Hsu disclose the basic claimed invention except for specifically disclosing the use of a plurality of hooks integrally formed into the housing body for facilitating hoisting the seamless housing body. Wokas teaches that it is known to place lifting means 14, equivalent to applicant's lifting means, into a housing body of a bathroom module. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Wokas' teaching into McCaul in view of Hsu's invention, because the lifting means will allow a crane or other lifting device to easily pick up and place McCaul's module. By using the lifting means taught by Wokas, one would not have to use a strap or other cumbersome device to pick up and place McCaul's modules. The lifting means taught by Wokas is in the form of a closed loop that can be gripped by a hook or other lifting device. Therefore, since applicant's lifting device is a closed loop that can be grasped in the same manner, the two devices are functionally equivalent.

Response to Arguments

Applicant's arguments filed November 22, 2004 have been fully considered but they are not persuasive.

First, the examiner would like to point out that the previous examiner's actions and decisions are not being relied upon by the present examiner. The applicant stated that the previous examiner withdrew a rejection based partly on the Hsu reference. The examiner would like to state that he believes that the Hsu reference is a pertinent reference. Therefore, the examiner is not withdrawing the rejection based on McCaul and Hsu.

In response to applicant's argument that McCaul and Hsu are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, prefabricated concrete structures are in the same field of endeavor. If one having ordinary skill in the art is going to try and develop a new prefabricated concrete enclosure, they would look to any prefabricated concrete enclosure that was known no matter what the concrete enclosure was to be used for. The concrete structural formation is the invention, not the manner in which it will be used. Therefore, the examiner takes the position that one having ordinary skill in the art would consider one prefabricated concrete enclosure in the same field of endeavor as a second prefabricated concrete module.

However, if the applicant still feels that the references are not in the same field of endeavor, then the examiner must show that it would be "reasonably" pertinent to the particular problem with which the inventor was involved. The inventor was involved in

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forming a concrete enclosure having four walls, a roof, and a floor all formed in a seamless fashion from concrete. Thus, one having ordinary skill in the art would consider a prefabricated, seamless concrete building module "reasonably" pertinent to the applicant's claimed invention. Therefore, the references should have logically commended themselves to the inventor's attention in considering his problem, i.e. how to form a seamless concrete enclosure.

The applicant further argues that neither McCaul nor Hsu disclose any reference to the term "vault". The examiner contends that the term "vault" merely implies a functional limitation. The term "vault" does not imply any specific structural features of the claimed device. It merely states what the structure is to be used for. The examiner would also like to state that the term "vault" could be used for other structures such as a "burial vault" or a "bank vault". Therefore, even though the claims are read in light of the specification, limitations from the specification are not read into the claims. The applicant must claim structural features that are not shown or taught by the prior art. Since McCaul in view of Hsu's building modules are capable of performing the same function as a vault, the examiner contends that they meet the claimed limitations.

Further, the applicant states that the inventors wanted to produce a "walk-in vault" that could be easily and quickly installed in pre-existing building. The examiner believes that this would also lead one having ordinary skill in the art to look at other prefabricated concrete structures. If one's intention was to build a concrete module that was to be built at one location and transported to a second location for installation, one would have almost certainly looked at the McCaul reference. This is exactly what the

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McCaul reference is doing. He wanted to produce a concrete module that could be quickly and easily installed in a building structure so that module would not have to be built in place. Therefore, even though one concrete module is called a "bathroom" module and one is called a "vault", they both have the same structure and are solving a similar problem, i.e. providing a faster and easier way to form and install concrete modules. Once again, one of ordinary skill in the art who was trying to develop a seamless, concrete module would have found it "reasonable" to look at the McCaul reference.

The applicant also argues that the McCaul reference does not disclose a seamless housing body. The examiner respectfully disagrees. The cross-section clearly shows that the sidewalls, the roof, and the floor are formed seamlessly. Further, figure 10 shows the junctions of the front wall and the rear wall with roof, sidewalls, and floor as a single line. This indicates that it is a seamless construction. For example, if the front wall and back wall were made separately and attached to the roof, floor, and sidewalls, the drawings would show a double line like the one shown in figures 2 and 4 of the Wokas reference where the front wall and side wall meet the floor. Therefore, McCaul does clearly show a seamless housing body formed of concrete.

The applicant further argues that Hsu does not disclose that his door is burglary proof because in order to be burglary proof a door must have a lock, which, by the way was not claimed. The applicant stated that "after all, the last thing people should have to do when a fire breaks out is to spend time breaking in to the fireproof room because, for example, they forgot their keys to the burglar proof door during the frantic dash to

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escape the fire.” The examiner would like to point out that every home he has ever been in has had a bathroom and as far as he can remember every bathroom had a lock on it so that the person using the bathroom could have some privacy without having someone open the door and barge in on them at an inopportune moment. Therefore, the examiner contends that it is notoriously well known that bathroom doors have locks. Further, I have never had to carry a key to get into my bathroom or any other bathroom for that matter. The door could be locked from the inside and shut from the outside so that no one could enter, or it could be locked and shut from the inside.

Finally, the applicant argues that Wokas does not disclose the use of a plurality of hooks. The examiner would like to point out that the applicant disclosed his “hooks” as reference number 124 in figure four. The examiner would like to state that the elements referenced by number 124 are not in the conventional shape of hooks. They are in the form of a closed loop or maybe an eyehook. However, the applicant did not refer to them as eyehooks. An eyehook and a hook have two very different shapes. In any case, Wokas discloses the use of a closed loop that can be grasped by a conventional lifting hook from a crane or similar device. Therefore, one closed loop is functionally equivalent to another closed loop. Therefore, Wokas’ lifting means is equivalent to and meets the claimed limitations of applicant’s claimed “hook” as interpreted in light of the specification.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Brian E. Glessner** whose telephone number is 703-305-0031. The examiner can normally be reached on Monday through Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Carl Friedman** can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the **Patent Application Information Retrieval (PAIR)** system. Status information for published applications may be obtained from either **Private PAIR** or **Public PAIR**. Status information for unpublished applications is available through **Private PAIR** only. For more information about the **PAIR** system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the **Private PAIR** system, contact the **Electronic Business Center (EBC)** at 866-217-9197 (toll-free).


Brian E. Glessner

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Primary Examiner
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B.G.
January 18, 2005